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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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DREIER & BARITZ LLP 499 PARK AVENUE 20TH FLOOR NEW YORK, NY 10022			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/819,338	HAJDUKIEWICZ ET AL. <i>Nev</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-79 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6.	6) <input type="checkbox"/> Other: ____.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 55 and 63 are objected to because of the following informalities:

- Claims 55 and 63 need periods at the end of the claims.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-79 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Claims 1-79 do not set forth a useful, concrete and tangible result. Applicant calculates an amount due to the customer, but the amount is not forwarded, refunded or credited to the user or user's account. Mere calculation of this amount falls short of providing the required useful, concrete and tangible result. Claims 54-69 lack the calculation of an amount due to the customer as well as the amount being forwarded, refunded or credited to the user or user's account.
- Claims 51 and 52 are not within the "technological arts." These claims do not require any computer-based steps, such that the claim could be carried out by

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hand. Applicant should include computer-based steps in the body of these claims in order to provide the requisite technology. See below.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful,

concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather,

statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, the body of the claims do not set forth at least one computer-based feature responsible for providing a non-trivial feature of the invention.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

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discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claims 1, 10, 19-21, 31, 41, 42 be found allowable, claims 72-79 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

- Claim 72 is the same scope as claim 1. The differences appear only to be "user" vs. "consumer" and "vehicle" fuel vs. "automotive" fuel. Applicant states (spec pg 4) that "vehicle" and "automotive" are used interchangeably. Further, fuel is fuel and where you intend to put the fuel (in an auto or in a vehicle) does not define the fuel. Further still, the claimed steps, structure, system and instructions are the same regardless of any class of fuel involved.
- Claims 73-79 are the same scope as claims 10, 19-21, 31, 41, 42 respectively. The differences appear only to be "vehicle" fuel vs. "automotive" fuel.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 41, 62-71, 78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5, it is unclear how price (a value) can include the other data/values.  
The program parameters define the other values.
- Claims 41 and 78, there is no antecedent basis for the purchase price.
- Claim 70, it is unclear what structure is represented by the means for developing a hedging strategy. This means plus function language is taken as an attempt to set forth a structure (112 6th Para). The hedging appears to be a parallel activity, not integrated into the structure (programmed computer system).
- Claims 62, 71, it is unclear what structure is represented by the means for guaranteeing price. This means plus function language is taken as an attempt to set forth a structure (112 6th Para). A “guarantee” is merely a promise to do something; applicant should claim either the steps performed which fulfill the promise or the apparatus (a programmed computer) which is capable of performing the steps which fulfill the promise, rather than the mere act of promising/guaranteeing or any promise/guarantee apparatus (if there is such a thing).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-50, 72-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCall et al (US6321984) in view of Oil Week (9-26-94 – Sun Joins co-branded card war with new MasterCard). McCall et al teaches a customer reward system whereby a preferred customer is identified, the stored customer's account benefits (discounted fuel price) are identified and fuel is sold to the customer at the discounted price [abstract, Example C – fig 7].

Regarding claims 1, 2, 9-11, 18-22, 29, 31, 32, 39, 41, 42, 72-79, the \$0.10 discount benefit that is accessed is taken to be a program price which is stored in the user account. The purchase of fuel triggers delivery of purchase information including a retail price of the fuel which is discounted by the user's stored benefit pricing. It appears that Riordan et al charges the user the calculated, discounted price rather than calculating a payment due (refund or rebate) to the customer. Oil Week (9-26-94) teaches a consumer incentive program (co-branded credit card) that provides discounted and free fuel. Oil Week (9-26-94) teaches that rebates can be given to the customer account for purchasing fuel. This rebate is taken as a teaching to charge retail prices and calculate the benefit amount as a payment due to the customer which

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is refunded subsequent to the fuel purchase. It would have been obvious to one of ordinary skill at the time of the invention to have provided the incentive system of McCall et al ('984) whereby the fuel benefit discounts were refunded to the customer who paid retail prices rather than discounting the retail price at the time of purchase.

Regarding claim 3, 12, 23, 33, 45, 48, Official Notice is taken that it is well known to provide savings benefits to consumers through either a discount from retail pricing or through a lower set price. It would have been obvious to one of ordinary skill at the time of the invention to have provided a benefit to the preferred consumers of McCall et al ('984) in the form of a set price such as \$0.75 per gallon. Such a price is taken to be "capped."

Regarding claim 4, 13, 24, 34, the prices exemplified in the applied references are taken to be in dollars which suggests the pricing is based on locations where the dollar is the accepted currency (i.e. the US).

As best understood regarding claim 5, 14, 25, 35, 43, 44, 46, 47, 49, 50, Oil Week (9-26-94) teaches time period and quantity limitations on the benefits as up to \$70 in free gas per year. The program is affiliated with BP gas products. It would have been obvious to one of ordinary skill at the time of the invention to have restricted the offer to the low grade of fuel rather than the premium grade so that BP need not give away the more expensive product. It would have been obvious to one of ordinary skill at the time of the invention to have captured and delivered the transaction parameters for verification such that the restrictions of the program could be carried out.

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Regarding claim 6, 15, 26, 36, the cards of Oil Week (9-26-94) are co-branded cards. Official Notice is taken that it is well known to provide finders fees for cooperating businesses who refer customers. It would have been obvious to one of ordinary skill at the time of the invention to have studied the economics of such a program and balanced the fees with the parameters of the program (program pricing) so that the participating businesses revenue losses are kept in check and within an acceptable level. In short, businesses launching such a program would be willing to pay a certain, controllable amount in return for building customer loyalty. The program pricing will be ultimately calculated in the best interest of the business.

Regarding claims 7, 8, 16, 17, 27, 28, 37, 38, it would have been obvious to one of ordinary skill at the time of the invention to have offered the program whereby the consumer pays for taxes or equally obvious, where the incentive program covers the taxes. Further, some states have sales tax, others do not. Further still, applicant's claiming of these two conflicting limitations suggests a lack of criticality for the features.

Regarding claims 30, 40, Official Notice is taken that fuel purchases at a retailer location includes storage of accounting data regarding the transaction including the location or dealer making the sale. It would have been obvious to one of ordinary skill at the time of the invention to have captured this data for accounting purposes.

5. Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCall et al ('984) in view of Oil Week (9-26-94) and Arizona Republic (6-14-97 – Sales gimmicks by automakers becoming more creative, selective).

Regarding claims 51-53, McCall et al ('984) teaches that the incentive program could be offered through alliances with other businesses, but does not describe any particular partnerships with car sellers. Arizona Republic (6-14-97) teaches the idea of providing incentives in order to sell new cars. Some of these incentives include attempts to provide loyalty programs, offering credit cards, offering debt cards for fuel and offers for (limited) free fuel upon a new car purchase. It would have been obvious to one of ordinary skill at the time of the invention to have provided the teachings of McCall et al ('984)/Oil Week (9-26-94) as an incentive for buying a new car in a manner as taught by Arizona Republic (6-14-97).

6. Claims 54-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCall et al ('984) in view of Infinity Trading ([www.infinitytrading.com/heating.htm](http://www.infinitytrading.com/heating.htm) - 1-9-98).

Regarding claims 54, 55, 59, 62, 63, 67, 70, 71, as stated above, it would have been obvious to one of ordinary skill at the time of the invention to have to have studied the economics (usage data being projected fuel usage, fuel product pricing, duration of program, etc) of such a program and balanced the parameters of the program (program pricing) with the expected benefits (customer loyalty, goodwill) so that the revenue losses are kept in check and within an acceptable level. In other words, the program pricing would not be arbitrarily set, but would be a sound business decision based on well known and available data – the essence of a business decision. Infinity Trading teaches the concept of guaranteeing a fuel price for customers and hedging the buy

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purchasing related futures in order to balance the risks of fuel price fluctuations. It would have been obvious to one of ordinary skill at the time of the invention to have done so for the fuel pricing of McCall et al ('984).

Regarding claim 56, 64, Official Notice is taken that retailers create different promotion pricing for different portions of the country have different retail pricing. It would have been obvious to one of ordinary skill at the time of the invention to have provided flexibility in program pricing for customers living in areas with high fuel prices or in areas with low fuel prices.

Claims 57, 58, 60, 61, 65, 66, 68, 69, are rejected as addressed above for claims 8, 7, 2, 3.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc